



Docket No.: 04970/000K363-USO
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sadaaki Mori

Application No.: 10/091,711

Confirmation No.: 7464

Filed: March 5, 2002

Art Unit: 3611

For: ELECTRIC POWER STEERING APPARATUS

Examiner: L. S. Lum

REQUEST FOR WITHDRAWAL OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

APR 08 2004

GROUP 3600

Dear Sir:

It is respectfully requested that the office action of March 22, 2004 in the above-identified patent application be withdrawn and that a new office action be issued, with a new response date. The reasons for this request are set forth below.

REMARKS

One ground for this request is that the examiner indicated that Claims 3-8 and 11-16 would be allowable "if rewritten to overcome the rejection(s) under 35 U.S.C. § 112 (2), set forth in this office action " and to be in independent form. The undersigned has found no rejections under 35 U.S.C. § 112 in this office action. It cannot be determined whether the examiner included the reference to those rejections through oversight or whether such rejections were intended to be made and have been omitted in error. The undersigned is therefore unable to determine what steps should

be taken to place Claims 3-5 and 11-16 in condition for allowance.

The examiner also refused to consider two of the three foreign patents submitted in the Information Disclosure Statement filed November 13, 2003. The only ground stated for this is that English translations of at least the abstract of those references were not provided.

It is respectfully submitted that the examiner has failed to comply with the Rules of Practice in refusing to consider the two foreign language references. First of all, there is no requirement in the rules that a translation of any portion of a foreign reference *must* be provided in order to have an Information Disclosure Statement considered. 37 C.F.R. §1.98(3)(ii) requires that a copy of a translation be provided only if it is within the possession, custody or control of, or is readily available to any individual designated in Section 1.56(c).” The applicants provided to the undersigned all information that was available and such translations were not among such information. The applicants therefore have no further obligation, and the examiner may not *arbitrarily* refuse to consider the Information Disclosure Statement, because no translations were present.

Furthermore, MPEP Section 609 III A(2) provides that: “if no translation is submitted, the examiner *will* consider the information in view of the concise explanation and insofar as it is understood on its face” (emphasis added). Clearly, the examiner has no option but to consider the references.

It is also noted that, in the present instance, the applicants submitted an English language search report in the corresponding European patent application. In accordance with MPEP Section 609 III A (3), this search report satisfies the “concise explanation” requirement, so the examiner has more than adequate information to consider the relevance of the two foreign language references.

Thus, the examiner is clearly in violation of the rules and required practice in the present instance and *must* consider the Information Disclosure Statement. The office action should therefore be withdrawn, the examiner should consider the two foreign references, and a new office

action should be issued, taking those references into consideration.

Finally, at Page 4 of the office action, the examiner states that, at the interview, the undersigned agreed with Ms. Morris' explanation regarding how Henry includes magnets fixed in recesses. The undersigned did not and does not agree with that explanation. During the interview, the undersigned discussed that interpretation and asked Ms. Morris what kind of language with respect to the recesses she would consider as distinguishing, in her view. The purpose for this was to better understand her position and how she was interpreting the reference. The undersigned never agreed with that position nor proposed that any actual amendment be made to the claims in view of it. The examiner is respectfully requested to refrain from characterizing statements made by the undersigned during the telephone interview.

For all of the above reasons, the office action of March 22, 2004 does not comply with the Rules of Practice, is improper, and should be withdrawn. Withdrawal of that office action and issuance of a new one is respectfully requested.

Dated: April 1, 2004

Respectfully submitted,

By 

Joseph B. Lerch

Registration No.: 26,936

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 753-6237 (Fax)

Attorneys/Agents For Applicant

